REMARKS

The present application was filed on October 30, 2003 with claims 1-36. Claims 1-28 have been canceled without prejudice and claims 29-36 remain pending. Claims 29 and 36 are the pending independent claims.

In the outstanding Office Action dated February 26, 2008, the Examiner: (i) rejected claim 36 under 35 U.S.C. §101; and (ii) rejected claims 29-36 under 35 U.S.C. §102(b) as being anticipated by S.A. Wolfman et al., "Mixed Initiative Interfaces for Learning Tasks: SMARTedit Talks Back" (hereinafter "Wolfman").

With regard to the Examiner's §101 rejection of claim 36, Applicants assert that an article of manufacture is patentable subject matter under 35 U.S.C. §101 ("Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title."). Nonetheless, Applicants have amended claim 36 to recite, an article of manufacture, stored in one or more memory devices, for customizing a control of a user-interface of an existing application. Support for this amendment may be found in the specification at, for example, page 12, lines 7-10. Accordingly, Applicants respectfully request that the §101 rejection of claim 36 be withdrawn.

With regard to the §102(b) rejection under Wolfman, Applicants initially note that it is well-established law that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Applicants assert that the rejection based on Wolfman does not meet this basic legal requirement.

With regard to the §102(b) rejection of independent claims 29 and 36, Applicants contend that Wolfman fails to teach each and every limitations of the recited claims because Wolfman discloses techniques unrelated to the present invention. Wolfman proposes an interface for machine learning that resembles a human teacher-student relationship. Wolfman, Abstract. Wolfman describes a variety of rich interaction modes that enhance the learning process and presents a decision-theoretic framework, called DIAManD, for choosing the best interaction. Id. The framework is applied specifically to SMARTedit and demonstrates experimental validation

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and preliminary user feedback. Id. As stated in the preamble of the independent claims, the present invention recites customizing a control of a user-interface of an existing application. See Claims 29 and 36. Wolfman does not propose to customize a control of a user-interface of an existing application.

It follows that Wolfman does not record a procedure description comprising a series of actions performed by a user in the application user-interface, and install a user-interface control relating to the procedure description in the existing application for automatic execution of the procedure description and generation of the series of actions performed by the user when the user-interface control is activated. In an illustrative embodiment, the specification describes adding new controls or modifying existing controls. Specification, page 5, lines 16-20. Further, the specification discloses, in another embodiment, that the creation of a new control may be the addition of a new button to an existing toolbar within an application. Specification, page 5, lines 20-21. Therefore, Wolfman does not disclose installing a user-interface control relating to the procedure description in the existing application for automatic execution of the procedure description and generation of the series of actions performed by the user when the user-interface control is activated, as recited in the claims and described in the specification.

Nonetheless, Applicants have amended independent claims 29 and 36, incorporating the preamble in to the claim limitations. The claims now recite, customizing the control of the user-interface of the existing application by installing a user-interface control relating to the procedure description in the existing application for automatic execution of the procedure description and generation of the series of actions performed by the user when the user-interface control is activated. Wolfman does not disclose customizing the control of the user-interface of the existing application as discussed above. For at least these reasons, Wolfman fails to anticipate independent claims 29 and 36.

It follows that claims 30-35 are patentable at least by virtue of their dependency on independent claim 29. Further, dependent claims 30-35 recite patentable subject matter in their own right. For instance, Wolfman does not teach receiving the application user-interface structure information from the operating system at the procedure capturer as recited in dependent claim 30. See Specification, pg. 6, lines 15-27. Also, Wolfman does not teach registering a procedure capturer with the operating system to receive notification of user actions and system
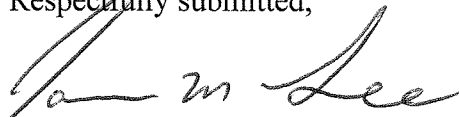
actions as recited in dependent claim 31. Further, Wolfman does not teach an installed control as recited in claim 34. Nor does Wolfman teach altering the appearance of at least one existing user interface control as recited in dependent claim 35. Altering the appearance of at least one existing user interface control is described in one illustrative embodiment of the specification at, for example, page 9, line 26, to page 10, line 9:

> In addition to adding new controls to an existing application, the inventive technique described herein can be used to alter the visible appearance of existing controls within an application. This kind of alteration of appearance is commonly known as "skinning." A set of alternate controls for existing operations can be created for any application. Underlying application controls may be invoked for the controls that are being reskinnned, by simulating the actions (e.g. Mouse click, key press) required to activate that control. Thus, it is possible to have a control that does not use a prerecorded procedure from the procedure repository, but simply passes the events to the operating system and application. For example, an overlay window may have a round button where the original application had a square button. When the round button is pressed by the user, the proxy simulates a press of the original square button.

Accordingly, Applicants respectfully request withdrawal of the §102 rejection of claims 29-36.

In view of the above, Applicants believe that claims 29-36 are in condition for allowance, and respectfully request withdrawal of the §101 and §102(b) rejections.

Respectfully submitted,

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James M Lee
Agent for Applicant(s)
Reg. No. 61,588
Ryan, Mason & Lewis, LLP
90 Forest Avenue
Locust Valley, NY 11560
(516) 759-4547